MODIFIED PTO/SB/33 (09-08)
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PRE-APPEAL BRIEF REQUEST FOR REVIEW

		Docket Number Q106386
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on _____	Application Number 10/767,143	Filed January 29, 2004
	Confirmation Number: 4295 First Named Inventor Pascal CHARROPPIN	
Signature Typed or printed name	Art Unit 3628	Examiner Shannon S. SALIARD

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

☑ The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

CORRESPONDENCE ADDRESS

Direct all correspondence to the address for SUGHRUE MION, PLLC filed under the Customer Number listed below:

WASHINGTON OFFICE
23373
CUSTOMER NUMBER

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)

☑ attorney or agent of record. Registration number 63,726

☐ attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____

/Stacey A. Fluhart/
Signature

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September 28, 2010
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☑ *Total of 1 form is submitted.

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of	Docket No: Q106386
Pascal CHARROPPIN	
Appln. No.: 10/767,143	Group Art Unit: 3628
Confirmation No.: 4295	Examiner: Shannon S. SALIARD
Filed: January 29, 2004	

For: DEVICE ALERTING TO EXPIRATION IN A FRANKING SYSTEM

PRE-APPEAL BRIEF REQUEST FOR REVIEW

MAIL STOP AF - PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Pursuant to the Pre-Appeal Brief Conference Pilot Program, and further to the Examiner's Final Office Action dated April 28, 2010, Applicant files this Pre-Appeal Brief Request for Review. This Request is also accompanied by the filing of a Notice of Appeal.

Applicant turns now to the rejections at issue:

1. Independent claim 5 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Baum in view of Boothby and Dlugos, and further in view of Official Notice.

Independent claim 5 recites, among other features, "when it has been determined that the current postal data has not changed, franking the mail item with the current postal data using a franking machine even though the date of application of the current postal data is out of date."

The Examiner concedes that Baum does not disclose means for receiving a decision of the operator whether to replace the postal tariffs, for updating them at the operator's request, but points to Dlugos as allegedly teaching this feature (Office Action, page 12).

The Examiner also takes Official Notice that it is known to continue to operate a franking machine with current postal data when it is determined that the postal data has not changed (Office Action, page 13). Applicants disagree.

This is not at all true if the date of the application of this current data is out of date. On the contrary, the cited art teaches replacing the old table of tariffs with a new table of tariffs when the date of application of the old tariffs is out of date (see e.g., Dlugos). For example, Dlugos discloses that that the Central Office informs the meter that the postal rates are changing and that the postal table of tariffs will require modification. Then the user must insert a module on a socket of the meter (column 4, lines 55-59). If a module is not inserted, the meter is out of service (column 5, line 2). On the other hand, if the module is present, a data communication is established between the Central Office and the meter, and the new rates are downloaded in the module (column 5, lines 15 and 37-40). Thus, the new tariffs all replace the old tariffs, and consequently, the old tariffs cannot be used after receiving this information from the central office. That is, in Dlugos, the user has no choice as to whether or not to replace the tariffs.

On the other hand, in the unique combination of claim 5, when the date of application of the new tariffs is reached, as in the prior art, these new tariffs are downloaded in the meter, but in contradistinction with Dlugos, the new tariffs do not replace the old tariffs.

In the Advisory Action, the Examiner cited Markl (U.S. 5,710,706) as support for the Officially Noticed position, specifically pointing to column 1, lines 20-33 (see page 2 of Advisory Action). However, this disclosure of Markl describes that a new rate table cannot be installed prior to the effective date of the rates in the new table, which causes a risk that out-of-

date postal information may be installed in the postal scale unless the new table can be installed on the effective date of the new table.

Thus, if Markl discloses the use of an out of date rate table, it is only a result of a lack of a new table being installed and is described as a "risk," i.e., this is not desirable. Thus, it would not have been obvious to have modified Baum, Boothby, and Dlugos based on the fact that it is known that an out of date table of rates may be applied only if a new rate table has not been installed as of the effective date of the new table. The combination of Baum, Boothby, and Dlugos includes a new rate that has been installed, and therefore, the out of date table would not continue to be used even after the effective date of the new table.

Thus, it is respectfully submitted that the combination of claim 5 is patentable over the cited art at least because none of the cited art disclose or suggest "when it has been determined that the current postal data has not changed, franking the mail item with the current postal data using a franking machine even though the date of application of the current postal data is out of date."

2. *Claim 8 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Baum in view of Boothby, Dlugos, and Official Notice, and further in view of Eckert (US 4,516,014).*

Eckert does not remedy the deficiencies of Baum, Boothby, and Dlugos in that Eckert does not disclose or suggest franking with current postal data even though the date of application of the current postal data is out of date. Therefore, claim 8 stands with claim 1.

3. *Claims 1-3, 6, 7, 9, and 10 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Baum et al. (US 7,103,583; hereinafter "Baum") in view of Boothby (US*

5,684,990 and Dlugos et al. (US 6,463,133; hereinafter "Dlugos"). Applicants traverse this rejection for at least the following reasons.

Claim 1 recites, among other features, "a franking machine which franks the mail item with the current postal data when it has determined that the current postal data has not changed, even though the date of the application of the current postal data is out of date."

Accordingly, claim 1 is patentable over the cited references for at least the same reasons discussed above relating to independent claim 5.

Furthermore, the Examiner alleges that although Baum does not disclose a comparing means for comparing one by one postal data in a first table with corresponding postal data in a second table, that Boothby discloses the one-by-one comparing and that it would have been obvious to have used this technique in Baum to yield predictable results (Office Action, page 6).

However, the reason why Boothby compares the data records one by one is because the data records of the first "table," e.g., a handheld computer, and the data records of the second "table," e.g., a desktop computer, are each independently updated (see column 1, lines 16-17). That is, each table must be reconciled with the other table. In the updating the postal tariffs, on the other hand, the updating occurs in one direction, i.e., the new tariffs replace the old tariffs. Therefore, such one-by-one comparison from Boothby would not be necessary in Baum and in fact would appear to be more complex than the comparison of release dates performed in Baum.

In the Advisory Action, in response to Applicants' above argument, the Examiner responded that additional advantages which would naturally flow from the suggestion of the prior art cannot be the basis of patentability. It is noted that the Examiner may not have understood the Applicants' argument. Applicants had argued that the motivation for providing

this feature in Boothby is not necessary in Baum, the primary reference. Consequently, it would not have been obvious to have modified Baum based on Boothby, irrespective of any additional advantages that result from such a combination.

Accordingly, claim 1 is further patentable over the cited references because it would not have been obvious to have modified Baum based on Boothby as proposed by the Examiner.

Claims 2, 3, 6, 7, 9, and 10 stand with claims 1 and 5 from which they depend.

4. Claim 4 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Baum in view of Boothby and Dlugos and further in view of Thiel (US 6,321,214).

Thiel does not supply the deficiencies of Baum, Boothby, and Dlugos in that Thiel does not disclose franking a mail item with the current postal data when it has determined that the current postal data has not changed, even though the date of the application of the current postal data is out of date, not does not Thiel disclose comparing the postal data one-by-one.

Accordingly, claim 4 stands with claim 1.

Respectfully submitted,

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